

REMARKS

Claims 1-2, 4-5, 7-13, 15, 17-20, 22, 24-31 and 33-34 will be pending upon entry of the present amendment. The amendments do not introduce new matter. Applicant does not intend by this amendment to abandon the subject matter of previously presented claims and reserves the right to pursue such subject matter in duly filed continuing applications.

I. Outstanding Rejections

The examiner effectively maintained the art-based rejection on the basis that the Whitley declaration submitted with applicant's previous response assertedly did not demonstrate prior possession (relative to U.S. Pat. No. 6,379 674 B1 issued to Rabkin et al.; hereinafter, "Rabkin") of the claimed subject matter drawn to HSV comprising GM-CSF-encoding DNA. Accordingly, claims 1, 2, 4, 17, 19, 20, 24, 31 and 33 stand rejected under 35 U.S.C. § 102(e) as anticipated by Rabkin. In addition, claims 1, 5, 19, and 22 are rejected under 35 U.S.C. § 103(a) over Rabkin in view of U.S. Pat. No. 5,328,688 (hereinafter, "Roizman '688"). Claims 1, 7-8, 12-13, 15, 18-19, 25-26, 30 and 34 are rejected under § 103(a) over Rabkin in view of Andreansky et al., Gene Ther. 5:121-130 (1998) (hereinafter, "Andreansky"). Finally, claims 1, 9-11, 19, and 27-29 were rejected under § 103(a) over Rabkin in view of U.S. Pat. No. 5,641,651 (hereinafter, "Roizman '651").

II. Patentability Arguments

The Examiner maintained the art-based rejections of the pending claims on the basis that the Whitley declaration, while demonstrating prior possession of HSV comprising either IL4-encoding DNA or IL10-encoding DNA, assertedly did not demonstrate prior possession of GM-CSF-encoding DNA. Accordingly, the Whitley declaration was not seen as effectively removing Rabkin, the primary reference cited against the pending claims. Consequently, the examiner effectively maintained all art-based rejections of the claims in the outstanding final Office Action.

In view of the outstanding Office Action having been made final, applicants have amended the claims to be drawn to HSV comprising IL4-encoding DNA, which is supported throughout the application-as-filed. Applicants further rely on the Whitley declaration, made of record by submission with applicants' previous response. The Whitley declaration demonstrates that the present inventors were in possession of the subject matter of

the claims as amended herein, and the declaration establishes that this possession was prior-in-time to Rabkin. In particular, see paragraph 6 of the Whitley declaration, describing the an HSV comprising an IL4-encoding DNA designated R8306, as well as notebook page 1 of Exhibit A attached to the Whitley declaration. Accordingly, Rabkin is not available as a reference against the claims as amended herein. Moreover, the defect created by the removal of Rabkin, the primary reference, is not remedied by any of the secondary references cited by the examiner in the outstanding Office Action, i.e., Roizman '688, Andreansky, or Roizman '652.

The examiner has already considered the Whitley declaration as well as Rabkin, Roizman '688, Andreansky, and Roizman '652 during examination. In addition, the examiner has considered claims not limited to a particular cytokine such as GM-CSF. For these reasons, applicants submit that the examiner would not have to perform an additional search or consider new substantive issues for examination. Applicants therefore request that the examiner exercise her discretion in entering and considering the present amendment.

Upon entry of the present amendment, applicants submit that all pending claims will be in condition for allowance and respectfully request notification thereof. If any issue(s) remains, the examiner is invited to contact the undersigned to expeditiously resolve the matter.

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Respectfully submitted,

By 

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